

Reply to Office Action
S/N 10/687,528

Remarks

Claims 1-24 are pending in the application. Claims 12-15 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,473,065 to **Miller**. Claims 1, 2, 4-11 and 18-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Miller** in view of U.S. Pat. No. 5,284,372 to **Lin**. Claims 3, 16 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Miller** as modified by **Lin**, and further in view of U.S. Pat. No. 2,427,909 to **Howell**. Claims 1-7, 10 and 20-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Howell** in view of **Lin**. The Applicant respectfully traverses the rejections of Claims 1-24, as discussed below.

I. Claims 12-15 Are Not Anticipated by Miller

Claims 12-15 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,473,065 to **Miller**. Each of these claims recites a "spindle having an inside end and an outside end, wherein the inside end of the spindle inwardly extends a substantial distance from the inside face of the garage door," and "an offset actuator yoke having a central hub portion on the inside end of the spindle, and having opposed ends, wherein the central hub is proximate to the inside end of the spindle and the opposed ends are substantially proximate to the inside face of the garage door." The specification describes one embodiment of the offset yoke as follows:

The yoke 108 includes a central hub portion 109 and two opposed radially extending ends 110, 111. The ends are configured to receive fasteners 117, 119. The ends 110, 111 are axially offset from the hub portion 109 by an axial distance "L" as shown in Figure 11. The offset ends 110, 111 of the yoke 109 permit the ends 110, 111 to be closely proximate to an inside face 2b of a door 2.

(p. 6, l. 20 -- p. 7, l. 2)

The lock described in **Miller** does not include an offset actuator yoke having a central hub portion on the inside end of the spindle, and having opposed ends, wherein the central hub is proximate to the inside end of the spindle and the opposed ends are substantially proximate to the inside face of the garage door, as recited in Claims 12-15. To the contrary, the circular cam 20 of **Miller** is described as being "in the form of a disc." (Col. 2, ll. 5-8) A circular disc has no "opposed ends" as required in Claims 12-15. In addition, the hub portion 19 of the circular cam 20 and the cam disc 20 of **Miller** are positioned together proximate to the center of a shaft 22,

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and are not offset as required by Claims 12-15. In addition, the hub portion 19 of Miller is not on an inside end of a spindle as required by Claims 12-15.

Therefore, Miller does not disclose every limitation recited in Claims 12-15, and the rejection of Claims 12-15 under 35 U.S.C. 102(b) should be withdrawn.

**II. The Office Action Has Not Made Out a Prima Facie
Case of Obviousness As To Claims 1-11 and 16-24**

The Examiner has the burden to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103(a). See MPEP 2142. To establish a *prima facie* case of obviousness, three basic criteria must be met. See MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See *Id.* Indeed, the proposed modification cannot render the prior art unsatisfactory for its intended purpose and cannot change the principle of operation of a reference. See MPEP 2143.01. Second, there must be a reasonable expectation of success. See MPEP 2143. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See *Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. See *Id.* (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

A. Claims 1, 2, 4-11 and 18-24 are Patentable Over Miller in View of Lin

Claims 1, 2, 4-11 and 18-24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of U.S. Pat. No. 5,284,372 to Lin. The Office action states, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an inside push button lock on the inside handle 25 of Miller, in view of the teaching of Lin. . . ."

Miller describes a garage door locking system that is substantially similar to the prior art locking system described in Applicant's specification (p. 2, l.17 – p. 3, l. 13) and shown in Figs. 5 and 8. As explained in Applicant's specification, such systems "cannot be locked or unlocked from the inside of a garage door...." Indeed, the structure of the Miller device prevents the addition of the inside lock of Lin. Lin describes a yokeless locking mechanism that is unsuitable

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for use with lockbars or latch cables. Accordingly, there is no teaching or suggestion in the references for the proposed modification of **Miller**. In addition, the proposed modification renders the **Miller** device unsatisfactory for its intended purpose. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Otherwise, the rejection is based on impermissible hindsight. Therefore, the Office Action does not establish a *prima facie* case of obviousness, and the rejection of claims 1, 2, 4-11 and 18-24 under 35 U.S.C. 103(a) should be withdrawn.

R. Claims 3, 16 and 17 are Patentable Over Miller and Lin in View of Howell

Claims 3, 16 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Miller** as modified by **Lin**, and further in view of U.S. Pat. No. 2,427,909 to **Howell**. The Office Action states "it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a key cylinder for the outside lock 40, 41 of **Miller**, in view of the teaching of **Howell**."

Miller and **Howell** each describe a garage door locking system that is substantially similar to the prior art locking system described in Applicant's specification (p. 2, l. 17 – p. 3, l. 13) and shown in Figs. 5 and 8. As explained in Applicant's specification, such systems "cannot be locked or unlocked from the inside of a garage door...." (p. 3, l. 10) Indeed, the structure of the **Miller** and **Howell** devices prevent the addition of the inside lock of **Lin**. **Lin** describes a yokeless locking mechanism that is unsuitable for use with lockbars or latch cables. Accordingly, there is no teaching or suggestion in the references for the proposed modification to **Miller** in view of **Lin**, and further in view of **Howell**. In addition the proposed modification of the **Miller** and **Lin** devices renders them unsatisfactory for their intended purposes. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Otherwise, the rejection is based on impermissible hindsight. Therefore, the Office Action does not establish a *prima facie* case of obviousness, and the rejection of claims 3, 16 and 17 under 35 U.S.C. 103(a) should be withdrawn.

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C. Claims 1-7, 10 and 20-22 are Patentable over Howell in View of Lin

Claims 1-7, 10 and 20-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over **Howell** in view of **Lin**. The Office action states, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an inside lock on the inside handle of **Howell**, in view of the teaching of **Lin**...."

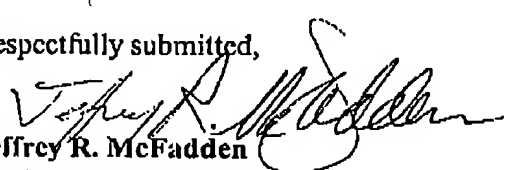
As discussed immediately above, **Howell** describes a garage door locking system that is substantially similar to the prior art locking system described in Applicant's specification (p. 2, l.17 – p. 3, l. 13) and shown in Figs. 5 and 8. As explained in Applicant's specification, such systems "cannot be locked or unlocked from the inside of a garage door...." Indeed, the structure of the **Howell** device prevents the addition of the inside lock of **Lin**. **Lin** describes a yokeless locking mechanism that is unsuitable for use with lockbars or latch cables. Accordingly, there is no teaching or suggestion in the references for the proposed modification to **Howell**. In addition the proposed modification of the **Miller** and **Lin** devices renders them unsatisfactory for their intended purposes. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Otherwise, the rejection is based on impermissible hindsight. Therefore, the Office Action does not establish a *prima facie* case of obviousness, and the rejection of claims 1-7, 10 and 20-22 under 35 U.S.C. 103(a) should be withdrawn.

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Conclusion

Applicant believes this case is now in condition for the immediate allowance of Claims 1-24, and such action is respectfully requested. If any issue remains unresolved, however, Applicant's attorney welcomes the opportunity for a telephone interview to expedite allowance and issue.

Respectfully submitted,


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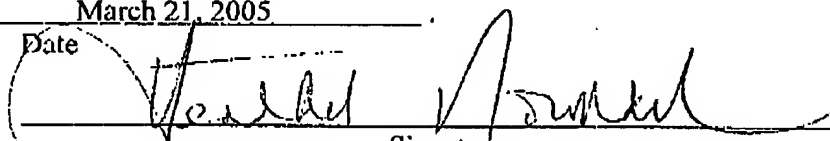
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Reply to Office Action regarding patent application serial number, 10/687,528, filed October 16, 2003.

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